



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,785	09/13/2000	Benjamin E. Hansen	1692	7918
20350	7590	07/01/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			FOSTER, ROLAND G	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/660,785	HANSEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Roland G. Foster	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4, 6-14 and 16-31 is/are pending in the application.  
 4a) Of the above claim(s) 26-31 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4, 6-14, and 16-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2005 has been entered.

### ***Response to Arguments***

Applicant again argues that examiner relied upon "facts within the personal knowledge" of the examiner in order to supply motivation in an obviousness rejection and thus the examiner is required to provide documentary proof or an affidavit.

Applicant's arguments were duly considered by are not deemed persuasive. The examiner relied upon knowledge generally available to one of ordinary skill in the art. Thus, the rejection is not based upon facts within the personal knowledge of the examiner. 37 CFR § 1.104(d)(2) refers to situations where the examiner purports to have some personal knowledge about the prior art (e.g., personally witnessing prior art in the past).

***Election/Restrictions***

A detailed examination of the originally presented claims 1-4, 6-14, and 16-25 was mailed on July 13, 2005. In response, the applicant filed a request for continued examination that added new claims 26-31.

The newly presented claims are patently distinct. Specifically, the new claims appear to be substantially directed to a user interactions with a windows-based, graphical user interface ("GUI"), such as a first "pop-up" window (claim 26) that displays a message comprising various "button" controls (e.g., claims 27-31) and a second "pop-up" window that is generated in response to selecting one of the buttons. These windows-based, GUI limitations were not present in the originally presented claims and encompass a field of subclasses within class 715 (as discussed below), thus creating extensive and facially objective evidence of patentable distinctness.

In addition, administrative burden exists because the newly presented claims have a different classifications, fields of search, and status in the art.

In addition, administrative burden exists because the newly presented claims have a different classifications, fields of search, and status in the art.

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right).

MPEP § 819.

A restriction requirement under the above circumstances has several benefits. The restriction requirement promotes a clear and complete prosecution history of a single, original invention. The requirement promotes the quality, administrative determination of patentability for both the applicant and for the public.

Therefore, the following restriction requirement will be set forth based upon election by original presentation.

**Patentable Distinctness**

*Description of the Separate Inventions*

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Invention 1: originally presented claims 1-4, 6-14, and 16-25, drawn to a method for managing telephone calls where an application server obtains from an Internet Access Server an IP address relating to the called station, wherein the Internet Access Server is a different server from the application server..

Invention 2: newly submitted claims 26-31, drawn to method for managing telephone calls based on the use of a windows-based, GUI comprising multiple, inter-related pop-up windows and control buttons.

*The Subcombinations Are Patentably Distinct From Each Other*

Inventions 1 and 2 are related as subcombinations disclosed as usable together in a single system for managing telephone calls.

Subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention 1 has separate utility as a system for obtaining the Internet address of the called station using a remote Internet Access Sever. Invention 2 has separate utility has a system for managing calls using a user-friendly windows-based, GUI. See MPEP § 806.05(d).

Administrative Burden

*Separate Classification and Different Field of Search*

Inventions 1 and 2 have separate classifications and fields of search as discussed below.

Invention 1 includes classification in class 379, subclass 354, network having separate elements (e.g., the Internet Access Server) to handle circuit switched (telephone call) traffic.

Invention 2 includes classification in class 715 across multiple subclasses such as subclass 700 (GUI interfaces), subclass 781 (windows and viewpoints), subclass 808 (pop-up control), and subclass 764 (manipulation of distinct interface elements including buttons). Thus, the field of search for Invention 2 would significantly diverge from the field of search for Invention 1, which does not require any substantial consideration of windows-based GUI(s) and GUI elements such as pop-up windows and control buttons.

*Separate Status in the Art*

A separate field of search (as discussed above) also shows a separate status in the art (MPEP § 808.02). Thus, Inventions 1 and 2 also have separate status in the art.

*Conclusion – Administrative Burden*

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one Invention is not required for the other Inventions for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter for the reasons given above, restriction for examination purposes as indicated is proper.

Constructive Election by Original Presentation

Since applicant has received an action on the merits for the originally presented Invention I (drawn to claims 1-4, 6-14, and 16-25), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Invention II (drawn to claims 26-31) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 819 and 821.03.

For the above reasons, the following rejections are repeated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-14, 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,259,692 B1 to Shtivelman et al. ("Shtivelman '692"), of record, in view of U.S. Patent No. 6,353,611 B1 to Norris et al. (Norris '611), of record.

With respect to claim 1, see the following paragraphs for details on how Shtivelman '692 discloses particular limitations within the claim.

The limitation "forwarding the called station telephone service to an application server upon connection of the called station to the data network" reads on Shtivelman '692 as follows. A subscriber places a call in order to log onto his Internet service provider (ISP) (connection to the data network) (Fig. 1 and col. 4, lines 55-60). Upon connection, subsequent calls to the subscriber's telephone 11 (called station telephone service) will be forwarded by telephony switch 151 to telephony switch (with IP interface) 141 (Fig. 1 and col. 4, line 67 – col. 5, line 3). The telephony switch (with IP interface) 141 provides subscriber services such as Internet call waiting (col. 5, lines 4-15) and thus can be considered an "application server."

The limitation "responsive to a telephone call from a calling station, forwarding the telephone call to the application server" reads on Shtivelman '692 as follows. When a caller at

telephone 16 places a call to the subscriber (col. 4, lines 47-54), the call is forwarded to telephony switch (with IP interface) 141 (application server) as discussed above.

The limitation "at the application server, obtaining from an Internet Access Server, an IP address relating to the called station, wherein the Internet Access Server is a different server from the application server" reads on Shtivelman '692 as follows. The telephone switch 141 (application server) obtains from an ISP (Internet access server) an IP address relating to the called station (col. 5, lines 28-36) where the telephone ISP 130 (Internet access server) is a different server from the switch 141 (application server).

The limitation "sending a query to the called station via the data network" reads on Shtivelman '692 as follows. When a caller at telephone 16 places a call to the subscriber (col. 4, lines 47-54), a call waiting alert signal is sent to the subscriber's computer station 112 that serves as a query for the subscriber to respond (col. 5, line 23 – col. 6, line 20).

The limitations "where the query includes a list of call disposition options for said telephone call" and "receiving a decision on the disposition of said telephone call from the called station" reads on Shtivelman '692 as follows. The subscriber decides to dispose of the waiting call by selecting from a list of options. For example, the subscriber can select to accept the call as an Internet call, select a prerecorded message to play to the caller, accept the call as a PSTN call, forward the call to selected numbers, or not to answer the call (col. 5, line 57 – col. 6, line 20).

Although Shtivelman '692 discloses the option of routing the incoming call to other telephone devices such as alternate or cellular telephones (col. 6, lines 1-20), Shtivelman '692 fails to specifically disclose that the list of call disposition options includes sending the telephone call to voicemail.

However, Norris '611 (similarly to Shtivelman '692) also teaches of an Internet call waiting system (abstract) that provides incoming call routing options such as the option to route the incoming call to voicemail (col. 5, lines 55-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option of routing the incoming call to voicemail as taught by the Internet call waiting system with incoming call routing of Norris '611 to the routing options disclosed by the Internet call waiting system with incoming call routing disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the efficiency, flexibility, user-friendliness, and versatility of the income call routing system disclosed by Shtivelman '692 by allowing an incoming call to be routed to voice mail in cases where the called party would like to record a message from the incoming party but does not consider the call important enough to suspend current work and dedicate time to answer in real time as would have been notoriously well known in the art of call screening systems and common business

practices. Further, Shtivelman '692 discloses that the called party can select alternate routing options such as routing to a cellular telephone. It would have also been notoriously well known in the art that both telephones and cellular telephone are often coupled to voice messaging systems either locally (e.g., telephone answering devices) or at the network level (e.g., voice mail systems). Therefore, the simple act of routing the call to a telephone equipped with or subscribing to a voice messaging service would have provided an option to route to voicemail with very little structural modification required.

Claim 11 differs substantively from claim 1 in the following manner. Claim 11 recites that the call is forwarded to an intermediate server instead of an application server as in claim 1. However, the telephony switch (with IP interface) 141 is a server that is intermediately positioned between the caller and the Internet service provider (ISP) that the called party is using (Fig. 1 and col. 4, lines 55-60). In addition, claim 11 recites that the query is sent "via the Internet" and "request[s] a decision from a list of call disposition options" which reads on the ability of the subscriber, in response to the query sent via the Internet, to select from a plurality (list) of call disposition options as discussed in the claim 1 rejection above. Claim 11 also recites that the query to the called station is accompanied by a "calling station identification" which reads on col. 5, lines 53-56. Finally, claim 11 recites that the call disposition actions are performed which reads on col. 5, line 57 – col. 6, line 20.

Claim 23 differs substantively from claim 11 in that claim 23 recites that the forwarding occurs upon said called station launching "Internet connection software" instead of an Internet

connection as in claim 11. However, this limitation reads on col. 4, lines 55-65. Specifically, the client's computer dials up the Internet service provider (ISP). Therefore, the computer comprises Internet connection software that is launched to accomplish the dialing. The dialing string also contains the call forwarding command that causes the forwarding to occur. Therefore, the forwarding occurs upon the called station's computer launching the Internet connection software required to dial up the ISP.

With respect to claims 2-4, 6, 7, 12-14, 16, and 17, see the claim 1 rejection above for further details.

With respect to claims 8 and 18, the caller would be on hold while the caller is listening to a pre-recorded message.

With respect to claims 9 and 19, Shtivelman '692 fails to specifically disclose that the incoming call is routed to a conference bridge.

However, Norris '611 also teaches of an Internet call waiting system (abstract) that provides incoming call routing options such as the option to route the incoming call to a conference bridge (Fig. 8 and col. 8, lines 51-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option of routing the incoming call to a conference bridge as

taught by the Internet call waiting system with incoming call routing of Norris '611 to the routing options disclosed by the Internet call waiting system with incoming call routing disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the flexibility, user-friendliness, and versatility of the income call routing system disclosed by Shtivelman '692 by allowing an incoming call to be conferenced such as in business environments where the ability to conference incoming calls is a standard and well-used feature. In addition, Norris '611 recognizes specifically that a conferencing feature would be an improvement over prior art Internet call-waiting systems (col. 2, lines 1-17) such as the system disclosed by Shtivelman '692.

With respect to claim 10 and 20, the called party can choose to answer the call (see the claim 1 rejection) and therefore has to option to hang-up.

With respect to claim 21, although Shtivelman '692 discloses that the incoming call is provided with caller ID information (see the claim 1 rejection above and col. 5, lines 53-56), Shtivelman '692 fails to specifically disclose that the caller ID information is stored, such as in a database.

However, an "Official Notice" was set forth in a prior Office action that both the concept and advantages of storing caller ID information when the called party chooses an option to

receive or process (such as routing to voicemail) the incoming call would have been well-known and expected in the art. This is especially the case in the art of call-logging and voice mail systems which both often use caller ID devices to store the incoming caller ID data for later retrieval, display, and/or screening purposes. However, the applicant's decision not to traverse the Official notice is taken as an admission of the fact(s) noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option to store caller ID information to the system that provided caller ID information for incoming calls as disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the versatility and user-friendliness of caller ID based systems by storing the caller ID data in a database for later retrieval and/or display such as when the called party is not present during incoming calls or when the called party wishes to document incoming calls. This is notoriously well known in the art of local, caller-ID devices and also well known in the art of screening and voice mail systems as well.

With respect to claims 22, 24, and 25, see col. 5, lines 40-67.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
June 27, 2005.